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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,043	12/18/2001	Steven G. Henry	10016441-1	6084

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 10/025,043	Applicant(s) HENRY, STEVEN G.	
	Examiner Laurie Ries	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 13 June 2006, to the original application filed 18 December 2001.
2. Claims 1-7, 9-12, 14-22, 24-27, and 29-34 remain under 35 U.S.C. 102(b) as being anticipated by Mitchell (U.S. Patent 5,693,966).
3. Claims 8 and 23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (U.S. Patent 5,693,966).
4. Claims 13 and 28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (U.S. Patent 5,693,966) in view of Block (U.S. Patent 6,295,543).
5. Claims 1-34 are pending. Claims 1, 15, 29, and 34 are independent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7, 9-12, 14-22, 24-27, and 29-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitchell (U.S. Patent 5,693,966).

Regarding claims 1, 15, 29, and 34, Mitchell teaches a method for accessing network data associated with a document (See Mitchell, Figure 3) comprising:

Converting at least a portion of said document to electronic format with a digital capture input device (See Mitchell, Figure 5, element Scan, wherein paper document is scanned. It is inherent that a scanner is used which is a digital capture input device), the at least a portion of said document having one or more indicia thereon (See Mitchell, Figure 2, element Indexing on portion of document. Also see Column 2, lines 60-65) the digital capture input device being operatively associated with a network (Since data is converted in to electronic format accessible by network or Internet as described in the Abstract, lines 1-3, it is inherent that scanner is operatively associated with network)

Analyzing the at least a portion of said document in electronic format to obtain said one or more indicia (See Mitchell, Figure 2, element Indexing. Also see Column 2, lines 60-65, wherein indexing information is obtained)

Using said one or more indicia to locate said network data, network data not including said document (See Mitchell, Figure 4, specifically, Column 7, lines 15-20, 32-

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37, and 47-54, wherein Mitchell teaches a table of contents in a document represented as hyperlinks and those hyperlink documents can also be viewed. Hyperlinks within the document are considered as additional network data other than document, which is consistent with applicant's specification on Page 5, lines 1-14, wherein additional network data can be forms or coupons. It is inherent that forms or coupons are documents with hyperlinks within the documents) said network data being maintained at another device operatively associated with the network (See Mitchell, Figure 2, element Processing Environment, wherein a network data is obtained and

Automatically accessing said network data (See Mitchell, Figure 3, element User accessing and retrieving networking information. Network data can be accessed automatically as described in Mitchell, Column 7, lines 32-35). It is inherent that network data is located on a network server (another device).

Regarding claims 2, 17, and 31, Mitchell teaches the claimed invention of indexing comprising portion of text and document as described in Column 2, lines 60-67, wherein Mitchell teaches indexing schemes to retrieve pages containing graphics and text as described in Column 2, lines 67- Column 3, lines 10, and as shown in Figure 2, element Tagged version text/graphics.

Regarding claims 3, 18, and 32, Mitchell teaches the claimed invention of providing the at least a portion of said document with one or more tags before the at least a portion of said document is converted to electronic format with said digital capture input device; analyzing the at least a portion of said document in electronic format to obtain said one or more tags; and

Using said one or more tags to locate said network data (See Mitchell, Figure 2, wherein a portion of the document is tagged before being converted into electronic format. Portion is indexed which is equivalent to analyzing to obtain tag information and to obtain network data. Also see Mitchell, Column 3, lines 1-10.

Regarding claims 4, 19, and 33, Mitchell teaches HTML tags. It is inherent tags are HTML tags which are machine readable as claimed.

Regarding claims 5, 6, 10, 20, 21, and 25, Mitchell teaches the claimed invention of receiving network data at user or input device as shown in Mitchell, Figure 3, element User Display.

Regarding claims 7 and 22, Mitchell teaches the claimed invention of printing network data as described in Mitchell, Column 2, lines 30-34. Also see Mitchell, Figure 15, which describes printing at different resolutions.

Regarding claims 9 and 24, Mitchell teaches the claimed invention of receiving data at network device as described in Mitchell Abstract, lines 1-3.

Regarding claims 11 and 26, Mitchell teaches the claimed invention of sending portion of document from scanner to user as shown in Mitchell, Figure 3

Regarding claims 12 and 27, Mitchell teaches obtaining one or more indicia using character recognition as shown in Mitchell, Figure 2, element Indexing and OCR. OCR is also shown in Mitchell, Figure 3.

Regarding claims 14, 16, and 30, Mitchell teaches scanning as described above. It is inherent that scanner is multi-function device with scanning and converting functions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (U.S. Patent 5,693,966).

Regarding claims 8 and 23, Mitchell teaches the claimed invention as described above with respect to claim 1. Mitchell teaches receiving network data through the Internet as described in Mitchell, Abstract, lines 1-3. However, Mitchell fails to teach receiving as e-mail. E-mail is received through the Internet as is well known in the art. An official notice is taken. Therefore it would have been obvious for a person with ordinary skill in the art at the time of the invention to incorporate well-known method of receiving data with e-mail in the method of Mitchell because it provides customized data.

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8. Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (U.S. Patent 5,693,966) in view of Block (U.S. Patent 6,295,543).

As per claims 13 and 28, Mitchell teaches the claimed invention as described above with respect to claim 1. Mitchell fails to teach determining frequency for each of one or more words, comparing the frequency to word frequency list and using a result to locate network data. However, Block does. Specifically, Block teaches the claimed invention of determining frequency for each of one or more words (See Block, Figure 3, element Frequency calculation. Also see Block, Column 3, lines 45-55) comparing the frequency to word frequency list and using a result to locate network data (Block teaches calculating correlation between word and class based on frequency, which is interpreted equivalent to claimed comparison).

Therefore it would have been obvious for a person with ordinary skill in the art at the time of the invention to incorporate frequency calculation in the method of Mitchell because it provides relevance data for classification purposes, which is desired.

Response to Arguments

9. Applicant's arguments filed 13 June 2006 have been fully considered but they are not persuasive.

Applicant argues on Pages 9-10 of the Instant Amendment that Mitchell fails to teach that information retrieved by hyperlinks comprise network data, because, as Applicant states, the hyperlinks of Mitchell merely link to other portions of the document. The Office respectfully disagrees. Mitchell teaches that the links may be to other HTML documents as well as to other pages of the document (See Mitchell, Column 7, lines 51-53).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., additional information relating to the document itself) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER